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09/618,307

07/18/2000

Clements C. Lambeth

WEYE115226

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EXAMINER

FOX, DAVID T

ART UNIT

PAPER NUMBER

1638

NOTIFICATION DATE

DELIVERY MODE

11/01/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@weyerhaeuser.com

## Office Action Summary

**Application No.**

09/618,307

**Applicant(s)**

LAMBETH ET AL.

**Examiner**

David T. Fox

**Art Unit**

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-29 and 32-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33-35 is/are allowed.
- 6) ☒ Claim(s) 29-29 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

***Request for Continued Examination***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 21 August 2007 has been entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant's amendments of 21 August 2007 have overcome the art rejections based on Hormaza et al, which fails to teach or suggest the newly claimed method of conifer tree breeding.

***Indefiniteness***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32 is indefinite in its recitation of "the conifer species" which lacks antecedent basis in Claim 20 on which it depends.

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**Obviousness**

Claims 20-29 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Bridgwater in view of El-Kassaby et al, further in view of Stoehr et al (1998), as stated on page 5 of the Office action mailed 07 March 2007 for claims 20-31.

Applicant's arguments filed 21 August 2007 have been fully considered but they are not persuasive. Applicant urges that there is no suggestion to combine the references, that the combined references fail to disclose every element of the claimed invention, that there was a long-felt need for the claimed invention, and that the Examiner's prior characterization of a portion of the 2006 Lambeth declaration cited in support of the long-felt need was incorrect.

The Examiner maintains that the Board has previously affirmed the Examiner regarding the suggestion to combine the cited references, as stated on page 5 of the Office action mailed 07 March 2007, fourth paragraph. The Examiner further maintains that the Board has previously stated that at least parts (a-e) of claim 20, and dependents, were indeed taught by the cited combination of references (see, e.g., page 5 of the Office action of 07 March 2007, *ibid.*) Applicant's amendment of part (f) of claim 20 does not in any meaningful way distinguish the claimed invention from the previously cited combination of references.

Regarding the alleged long-felt need, the Examiner notes that such an allegation was based upon the asserted reduction in time and expense of tree breeding. However, Applicant has not reduced steps (c-f) of claim 20 to practice. Therefore, the

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Examiner is unable to ascertain whether or not the claimed invention did or did not achieve the alleged benefits.

**Conclusion**

Claims 32-35 are deemed free of the prior art, given the failure of the prior art to teach or reasonably suggest a method of loblolly pine breeding comprising the combination of pedigree breeding, polymix breeding, and DNA markers.

Claims 33-35 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (571) 272-0795. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached on 571-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

October 26, 2007

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 180-1638

